

Application No.: 10/081,564
Amendment and Response dated June 9, 2004
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REMARKS

Claims 1-24 remain in this application. Claims 2-5, 7 and 16 have been amended. Applicants respectfully request reconsideration in view of the following remarks.

Applicants' Response to Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 2-5 and 7 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

Applicants have amended claims 2-5 to clarify that the monomers correspond to the urethane acrylate monomers recited in claim 1.

Applicants have amended claim 7 to recite the relationship of the polyester aliphatic urethane acrylate to the di- or poly-functional urethane acrylate of claim 1.

Therefore, in view of the amendments to the claims and above remarks, Applicants respectfully request withdrawal of the Section 112, second paragraph rejections.

Applicants' Response to Rejections Under 35 U.S.C. §112, First Paragraph

Claims 16 and 17 are rejected under 35 U.S.C. §112, first paragraph, as allegedly being non-enabled.

Applicants have amended claim 16 to include the recitation that the composition when cured has a Shore A hardness of about 55 or less. Claim 17 depends from claim 16, and thus, contains all the limitations of amended claim 16. In view thereof, Applicants respectfully request withdrawal of the Section 112, first paragraph rejection.

Applicants' Response to Rejections Under 35 U.S.C. §102

Claim 16 is rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Nos. 5,847,021 or 6,107,361 to Tortorello et al. (hereinafter collectively "Tortorello").

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Applicants traverse this rejection based on the failure of Tortorello to disclose each and every element of Applicants' amended claim.

The Examiner contends that Tortorello discloses radiation curable glass fiber coating compositions comprising a polyfunctional urethane acrylate, a monofunctional urethane acrylate, a reactive diluent and a photoinitiator. The Examiner further contends that Tortorello discloses the use of these components in the quantities recited in claim 16.

Tortorello relates to optical glass fiber coating compositions. As taught by Tortorello, the coating compositions include: about 5-70 wt.% of a urethane oligomer (a); about 5-70 wt.% of a urethane compound (b); about 5-70 wt.% of a reactive diluent (c); and about 0.1-10 wt.% of a photoinitiator.

Tortorello, however, fails to disclose, teach or suggest the invention as claimed in Applicants' amended claim. In particular, Applicants have amended claim 16 herein to recite the requirement that the composition when cured produces a Shore A hardness of about 55 or less. Nowhere in Tortorello is it disclosed, taught or suggested to use the combination of components as recited in Applicants' claim 16 to cure to a Shore A hardness of about 55 or less. As such, Tortorello fails to disclose each and every element of Applicants' amended claim.

It is well settled that to be an effective anticipatory reference, a cited document must disclose each and every limitation recited in a claim under examination. Failing such precise disclosure, such a cited document must fail as an anticipatory reference.

In view of the above, Applicants respectfully submit that the Section 102 rejection based on Tortorello has been overcome and should be withdrawn.

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Applicants' Response to Rejections Under 35 U.S.C. §103

Claim 17 is rejected under 35 U.S.C. §103(a) as allegedly being obvious over Tortorello in view of U.S. Patent No. 6,110,593 to Szum et al. (hereinafter “Szum”). Applicants traverse this rejection.

The Examiner contends that Tortorello discloses radiation curable compositions including the various components recited above. The Examiner admits that Tortorello fails to disclose the use of the specific reactive diluent recited in claim 17, i.e., 2(2-ethoxyethoxy)-ethylacrylate. The Examiner asserts, however, that Szum discloses the use of ethoxyethoxy ethylacrylate in radiation curable fiber coating compositions, and therefore, it would have been obvious to utilize this reactive diluent in the compositions of Tortorello.

As discussed in detail above, Tortorello fails to anticipate the invention as recited in Applicants' amended claim 16. Tortorello does not teach the combination of recited components that cure to a Shore A hardness of about 55 or less. Moreover, Szum is merely cited by the Examiner for its teaching of ethoxyethoxy ethylacrylate as a reactive diluent, and similarly fails to disclose, teach or suggest Applicants' curable compositions as recited in amended claim 16. Therefore, Szum fails to cure the deficiencies of Tortorello.

Accordingly, the combination of Szum and Tortorello fails to disclose each and every element of the invention recited in amended claim 16, and accordingly, claim 17, which depends from claim 16 and thus contains all the limitations thereof.

Moreover, Szum and Tortorello are not properly combinable references for an obviousness rejection because they are not analogous art. *See In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992) (“In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.”). In particular, Szum and Tortorello both are directed to coating

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compositions for optical fibers. Such coated fibers are used in optical fiber assemblies. There is no reason to believe that anyone skilled in Applicants' field of art would look to Szum or Tortorello for soft moldable compounds for use in hearing aids. Therefore, Szum and Tortorello are not properly combinable in an obviousness rejection against Applicants' claims.

In view of the above, Applicants' respectfully request reconsideration and withdrawal of the Section 103 rejection based on this combination of art.

Applicants' undersigned attorney may be reached by telephone at the number given below. All correspondence should continue to be directed to the address given below.

Respectfully submitted,



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